



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,382	12/12/2001	Michael Wayne Brown	AUS920010827US1	2851

43307 7590 11/03/2006

IBM CORP (AP)
C/O AMY PATTILLO
P. O. BOX 161327
AUSTIN, TX 78716

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,382

Applicant(s)

BROWN ET AL.

Examiner

Rasha S. AL-Aubaidi

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16, 18-25, 27, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16, 18-25, 27, 40 and 41 is/are rejected.
- 7) ☒ Claim(s) 7, 17 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-27 claims a computer program product comprising a recording medium, as disclosed in page 49 of the specification the recording medium comprises "transmission-type media such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example radio frequency and light wave transmissions." Therefore, the claims when interpreted in light of the specification are nothing more than a signal and a signal is nonstatutory subject matter; thereby making the claims nonstatutory. See Interim guideline page 55+.

Furthermore, "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer". See page 52 of the Interim guidelines. Since claims 21-27 fails to recite a computer program embodied in a computer-readable media as required by the Interim guideline, claims 21-27 are nothing more than are descriptive material per se and are not statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

4. Claims 1-6, 8-16, 18-25 27 and 40-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brown et al. (US PAT # 6, 826,276).

The disclosure is substantially the same as Brown reference (see col. 5, lines 32-42).

5. Claims 1-6, 8-16, 18-25, 27 and 40-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brown et al (US # 20030103619).

The disclosure is substantially the same as Brown et al, reference (see abstract of the invention and P.1).

Allowable Subject Matter

6. Claims 7, 17 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 17 and 26 are rejected for the same reasons as discussed above with respect to claim 7.

Response to Arguments

8. Applicant's arguments filed 12/02/2005 have been fully considered but they are not persuasive.

Art Unit: 2614

Regarding Appellant's statement (Appeal Brief, page 10) that "Brown '276 does not teach caller identity authentication". The Examiner respectfully disagrees because Brown et al. (patent 6,826,276) specifically teaches several authentication steps. Brown et al. teach that a caller ID will be compared with the caller profile database at step 98 (see col. 9, lines 1-4 and Fig. 6) in order to confirm the identity of the caller. Then, at step 100, a determination will be made of whether a caller ID matches a caller profile or not (Fig. 6) Brown et al. (col. 2, lines 40-49) clearly teaches the use of an identifier (caller ID) detected for a received call in order to provide service based on a caller. Thus, authenticating the caller in Brown et al. is a necessary feature especially in the scenario of redeeming the advancement tokens in order to prevent unauthorized callers from redeeming these advancement tokens.

Also Appellants states (Appeal Brief, page 12) "Brown '276 does not teach or enable an authenticated identifier for said caller or an identity of said caller is authenticated because the specification of Brown '276, when viewed as a whole, does not teach detecting an identity of a caller". However, the Examiner respectfully disagrees for the following reasons: First of all, the limitation "detecting an identity of a caller" or "authenticated identifier for said caller" as presented by the Appellant basically reads the same as ***detecting the caller ID*** since the caller ID is an identifier for said caller which is authenticated when it is compared to those IDs stored in the database for a match. Both limitations are broad and they technically lead to the same end result, which is validating and verifying the caller identity. Second, Brown '276 perform several

Art Unit: 2614

steps of authentication such as, detecting the caller ID and collecting other information (see col. 4, lines 34-35), then comparing the captured caller ID with the caller profile (see col. 9, lines 1-14) in order to provide the required service to the caller when the comparison yields a match, and this is the same as authenticating which involves comparing an identifier with stored identifiers to yield a match. All the preformed steps discussed above combined together authenticate the caller identity. Thus, Appellant's statement is not persuasive.

Appellant also states that "in view of the ordinary and customary meaning of "caller ID" and "authentication". Appellants respectfully assert that it is clear that comparing telephone number for a call (caller ID) with a database of caller profiles each associated with telephone numbers, as described in Brown '276, does not teach or enable identifying the actual identity of the caller, but merely identifies a caller profile previously associated with the telephone number used". The Examiner disagrees and asserts that comparing telephone number (caller ID) with a database of caller profiles is a method of verification steps. In fact, to authenticate an identifier is nothing more than comparing it with a database of stored identifiers for a match, Brown therefore teaches authenticating and verifying the caller in order to prevent unauthorized callers to utilize certain services in the customer profile (such as redeeming advancement tokens) by comparing the caller ID with that of the customer profile.

In conclusion, Brown '276 and the present invention both describe a method of controlling caller position in a call hold centers.

Brown et al. (US # 20030103619) is a prior publication for US Patent Brown et al. (6, 826,276). Thus, all the arguments will be addressed for the same reason as US Patent Brown et al. (6,826,276).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on (571) 272-7493.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. In view of the Appeal Brief filed on 07/24/2006, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



RASHA S. AL-AUBAIDI
PATENT EXAMINER

Art Unit 2614
10/25/2006



WING CHAN
SUPERVISORY PATENT EXAMINER